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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/352,107 07/14/99 FAY

J 1001.3

021901  
SMITH & HOPEN PA  
15950 BAY VISTA DRIVE  
SUITE 220  
CLEARWATER FL 33760

QM22/0817

EXAMINER

WILLSE, D

ART UNIT

PAPER NUMBER

3738

DATE MAILED:

08/17/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/352,107**

Applicant(s)

**FAY**

Examiner

**Dave Willse**

Group Art Unit  
**3738**



☒ Responsive to communication(s) filed on Jul 14, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The disclosure is objected to because of the following informalities: On page 1, line 31, "if" should be replaced by --is--. On page 12, line 1, "trimmable" is believed to be the correct spelling, although the word does not appear in a standard dictionary; the same is true for "cuttable" on line 25. On page 16, line 2, "in" should be --is--. The "midregion 33" (page 13, line 8) is not indicated in the drawings. Appropriate correction is required.

Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preamble and the body of each claim are inconsistent. For example, the preamble of claim 1 implies that the distal attachment plate is an element of the prosthetic liner, but lines 4-5 indicate that the two are distinct elements, one being secured to the other. The same is true for the elongate arms; e.g., on the last two lines of claim 17, if the elongate arms are elements of the prosthetic liner, then wouldn't the "exterior surface" at these regions be on the arms themselves?

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lohmann, US 5,728,167. Flexibility in the radial direction and relative nonstretchability in the axial direction are deemed to be evident from column 4, lines 6-10 and 15-17. The elongate arms 36 are


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partially embedded within the stretchable material **34**, because “the inner and outer surfaces are saturated with the movement-opposing material” (column 4, lines 11-15).

Claims 1-15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is (703) 308-2903. The supervisory patent examiner is Vincent Millin, whose telephone number is (703) 308-1065. The receptionist's phone number is (703) 308-0858, and the main FAX numbers are (703) 305-3591, 3590.

dhw: D. Willse  
August 14, 2000

  
**DAVE WILLSE**  
**PRIMARY EXAMINER**  
**ART UNIT 3738**